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Docket No.: 3351-042

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

THOMAS S. HEATH

U.S. Patent Application No. 09/577,487

Filed: May 25, 2000

For: VIDEO MOSAIC

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: Confirmation No. 6601  
:  
: Group Art Unit: 2612  
:  
: Examiner: CHRISS S. YODER, III

**Petition under 37 C.F.R. 1.181**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions the Director to invoke his supervisory authority under 37 C.F.R. 1.181 to have the finality of the present Official Action (OA) mailed February 25, 2005 withdrawn as the OA was prematurely made Final by the Examiner.

Relevant to the instant issue, Applicant filed a Response Under Rule 1.116 (copy attached as Exhibit A) on December 23, 2004 in response to a Final Official Action mailed July 27, 2004 (copy attached as Exhibit B). Applicant's response did not present any amendments to the instant claims nor has Applicant submitted an Information Disclosure Statement.

On January 27, 2005, Applicant held a telephone interview with the Examiner (copy of the Interview Summary form is attached as Exhibit C) during which the Examiner stated that the finality of the July 27, 2004 Official Action was vacated and an office action on the merits would be forthcoming. Further, the Examiner stated that he was taking this action "[b]ased on Applicant's arguments . . . which have been found to be persuasive."

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The present Official Action mailed February 25, 2005 was issued and prematurely made Final by the Examiner. As stated by the Examiner, "[a]pplicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a)." Further, the February 25, 2005 OA relied on a new reference not previously made of record in rejecting Applicant's claims, i.e., the Hsieh reference (U.S. Patent 6,011,558).

MPEP §706.07(a), cited by the Examiner in the most-recent OA, states in relevant part specifically, "[u]nder present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement.**" (emphasis added) Based on the foregoing information concerning the development of the prosecution of the instant application, the Examiner erroneously made the most-recent OA final and the finality should be withdrawn at this time.

The Finality of the instant OA is premature and should be withdrawn because:

- (1) the new ground of rejection was not necessitated by any amendments by Applicant; and
- (2) the new ground of rejection was not necessitated by an IDS submitted by Applicant.

Specifically, as evidenced by the prosecution history, Applicant did not amend the claims subsequent to the Final OA of December 23, 2004. The Examiner rejected at least one claim, e.g., claim 1, in view of a new reference neither previously cited nor applied.

Further, Applicant did not submit an IDS subsequent to the Final OA of December 23, 2004. Therefore, the new reference applied by the Examiner could not be applied as a result of an IDS submitted by Applicant.

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Based on the foregoing, the supervisory authority of the Director of the USPTO under 37 C.F.R. 1.181 is requested to be invoked to withdraw the finality of the most-recent OA as being premature and cause the issuance of a new non-Final OA.

Respectfully submitted,

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ON THE DATE SHOWN BELOW

Roseanne Kaplan

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